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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,196	04/09/2001	Ullrich Bernecker	H-2867-PCT/U	8711

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HENKEL CORPORATION
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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/26/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,196

Applicant(s)

BERNECKER ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-37 is/are pending in the application.
- 4a) Of the above claim(s) 35-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Receipt is acknowledged of election filed on 4/1/03. Claims 16-37 are pending in the application and the status of the application is as follows:

1. Applicant's election with traverse of group I in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the compositions of group I restore vitality to the hair and to improve the elasticity of skin which is accomplished by increasing the production of protein in human cells. This is not found persuasive because the method claim recites "method of treating skin or hair" which can be treating skin for disorders like acne or wrinkles or sunburn which is distinct from the method claimed in group II. Therefore it is the examiners position that the claims are drawn to two distinct and separate inventions and they lack unity as explained in paper no. 7.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 35-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Claims 16-34 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is new matter rejection.

There is no support in the specification for “ or combinations thereof” . the support in the specification at page 3, lines 5-8 are for individual components.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of the expression “ precursors there of “ for panthenol, tocopherol and vitamin A cannot be ascertained. The specification at pages 5-6 describes the derivatives and not “ precursors” . If applicants disagree with the examiner they are requested to point out the compounds contemplated for “ precursors there of” .

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 16-20, 27 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 394920('920).

The instant application is claiming a composition for treating hair or skin comprising:

1. biotin

2. glycoprotein

Applicants are notified that method claims are anticipated for the expression “method of treating hair” and the word treated is interpreted broadly.

See example . Since the glycoprotein is same claims 17-19 and 32 is inherent, absence of evidence to the contrary. The preamble to claim 27 is not given patentable weight as the claims are drawn to compositions. The expression “ comprising” permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive , even in major amounts. *Moleculon Research corp., v. CBS,Inc., 229 USPQ 805; In re Baxter, 210 USPQ 795, 803.*

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 16, 21-26, 28-29 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of admitted art at page 2, lines 10-19 EP'920 and U. S. Patent 5,571, 503('503).

12. The instant application is claiming a composition for treating hair or skin comprising:

1. *biotin*
2. *glycoprotein*
3. *penetration Auxiliary(claims 22 and 28)*
4. *protein hydrosylate(claims 23 and 29)*
5. *plant extract(claim 25)*
6. *panthenol or tocopherol derivative(claim 24)*
7. *film former (claim 26)*

The admitted art teaches the active ingredients 1 and 2 are used in cosmetics. the EP document teaches hair compositions using 1, 2, 6 and 7. the EP document does not teach the compositions for the treatment of skin and teaches ingredients 3-7. However the patent '503 teaches cosmetic compositions using 1, 3, 4, 5 and 6. see the abstract, see cols 2-3 and see the claims. The patent suggests the combination of all these ingredients as antipollution complex.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '920 and combine it with the *various additives* of '503, expecting beneficial effect to the hair or skin. The motivation to use the various

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additives stems from the teachings of '503 that the compositions provide significant protection of the skin. One of ordinary skill in the art would be motivated to use the additives for treating hair as these components are anti pollutants and when skin or hair is exposed pollutants it results in damage to the skin and hair and using these pollutant complex protects not only the skin but also the hair which is also exposed to pollution. This is a prima facie case of obvious ness.

13. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30: 1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


JYOTHSNA A VENKAT
Primary Examiner
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June 25, 2003